

REMARKS

New independent claim 9 replaces cancelled independent claim 1 and specifically provides for a sealing arrangement which includes a reciprocating hydraulic piston along with a stationary machine part with a bore for receiving reciprocating piston.

The provided U-cup seal is now defined by an inner surface formed on the U-cup seal which includes a lubrication bore reliefs for enabling passage of hydraulic fluid from a low pressure side of the sealing arrangement to a high pressure side of the sealing arrangement upon reciprocation of the piston. Support for this claim language may be found in the specification on page 6, for the full paragraph. Accordingly, no new matter has been added.

Traverse of the Examiner's objections will be made on the basis of the amended claims.

In that regard, claims 1-3, 5, and 8 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over U.S. 5,127,661 to Franson, et al. in view of U.S. 3,656,227 to Weinand.

In this rejection, the Examiner acknowledges that Franson fails to disclose that the inner surface comprises several lubrication bore reliefs that are recesses and accordingly looks to Weinand for a teaching of sealing member having a lip with the lip having an inner surface with recesses. The Examiner concludes it would have been

obvious to one having ordinary skill in the art at the time the invention was made to configure the inner surface of the lip of Franson to have recesses as taught by Wienand to provide the lubrication of return.

In response thereto, the Applicants submits that the Supreme Court in KSR International Company v. Teleflex, Inc. has issued its opinion regarding the issue of obviousness under 35 USC 103(a) when a claim recites a combination of elements of the prior art. KSR International Company v. Teleflex, Inc., no. 04-1350 (U.S. April 30, 2007).

In this decision, the court reaffirmed the Graham factors in the determination of obviousness under 35 USC 103(a). The court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the court recognized that the showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claim subject matter could provide a helpful incite in determining whether the claimed subject matter is obvious under 35 USC 103(a).

Moreover, the court noted that the analysis supporting a rejection under 35 USC 103(a) should be made explicit, in that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant art to combine the [prior art] elements" in the manner claimed.

The court further ruled that in determining whether the subject matter of a patent claim is obvious, the objective reach of the claim not the particular motivation

or the involved purpose of the patentee-controls. That is, if the claim extends to the obvious, it will be invalid under 35 USC 103(a).

Thus, the court concluded in the KSR that the appropriate question in the federal circuit is whether a paddle designer of ordinary skill, facing a wide range of needs created by developments in the field of endeavor, would have seen a benefit to upgrade either of the cited patents.

In the case at hand, it is clear that a designer of fluid seals, such as the Franson, et al. device, would not have seen the benefit to upgrade the Franson, et al. seal with the Weinand recesses to enable passes of hydraulic fluid in view of the fact that an objective of the Franson, et al. device is to provide seals which "prevent the loss of fluid around a moveable stem in a pneumatic valve", see column 1, lines 6-8. Thus, the incorporation of Weinand into Franson now would destroy the effectiveness of the Franson, et al. fluid seal.

The Applicants further submit that the references such as Franson, et al. and Weinand cannot properly be combined if the effect would destroy the invention upon which one of the reference patents is based. *Ex parte* Hartmann, 186 USPQ 366 (Patent and Trademark Office Board of Appeals 1974); *Ex parte* Sternau, 155 USPQ 733 (Patent Office Board of Appeals 1967).

Thus, on the basis that the references are improperly combined and further one skilled in the art would see no

benefit in doing so, the Applicants submit that the Examiner has not made a prima facie case of obviousness under 35 USC 103(a) for the rejection of claims 1-3, 5, and 8 and respectfully request the Examiner to withdraw this rejection.

Claims 4 and 6-7 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Franson and Weinand supplied to claims 1-3, 5, and 8 and further in view of U.S. 3,189,359 to Haberkorn.

In this rejection, the Examiner acknowledges that Franson, et al. and Weinand fail to disclose that the outer and inner surface of the abutment surface is convex and accordingly reaches to Haberkorn for teaching of a seal having a U-shape with an abutment surface, an inner surface, an outer surface adjacent to the abutment surface that are convex like a circular arc. The Examiner then concludes it would have been obvious to one of ordinary skill at the art at the time the invention was made to have the outer and inner surface of Franson and Weinand be convex as taught by Haberkorn to provide proper sealing under high pressure.

The Applicants submit that the teaching of Haberkorn add nothing to the improper combination of Franson, et al. and Weinand. Further, there is no teaching of recessed lubrication reliefs for enabling passage of hydraulic fluid from the low pressure side to a high pressure side of the sealing arrangement, as presently claimed.

Consequently, the Examiner has failed to provide a prima facie case of obviousness under 35 USC 103(a) for claims 4 and 6-7 based upon the combination of Franson, et al., Weinand, and Haberkorn. The Applicants respectfully requests the Examiner to withdraw this rejection.

In view of the arguments hereinabove set forth and amendment to the claims, it is submitted that each of the claims now in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectfully requested.

Respectfully submitted,



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